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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,036	01/20/2004	William L. Dunbar JR.	DEP 5033NP	1189
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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER HOFFMAN, MARY C	
			ART UNIT 3733	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/761,036

Applicant(s)

DUNBAR ET AL.

Examiner

Mary Hoffman

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 5, 7, 9, 11 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 9 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 11 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/20/04, 8/16/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

The abstract of the disclosure is objected to because the abstract is too short.

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 11 and 15-20 rejected under 35 U.S.C. 102(b) as being anticipated by Becker (U.S. Patent No. 2,248,054).

Becker discloses a tool comprising a body (ref. #5) having a proximal end portion (top portion of ref. #5) and a distal end portion (bottom portion of ref. #5), the distal end portion including a first and second flexible branch (see branches separated by lateral opening ref. #8) capable of gripping a spinal implant, the flexible branches being biased to a closed position; an inserter shaft (FIG. 2, including ref. #'s 12, 21, 22, 23, 19, 26, 20) slidably received within the body, the inserter shaft having a distal end (ref. #20) capable of holding a closure mechanism for the implant; a threaded collar (ref. #17), adapted to couple the body and the inserter shaft, wherein the inserter shaft is capable of forcing a spinal rod into the rod-receiving portion of the implant. The tool comprises a substantially cylindrical outer sleeve (ref. #6) disposed about the distal end portion of the body and movable between a first position and a second position in which the outer sleeve inhibits separation of the branches. (claim 4).

Becker further discloses a tool comprising a body (FIG. 4, ref. #5) having a proximal and a distal end portion, the distal end portion having branches (see branches separated by lateral opening ref. #8) capable of gripping a spinal implant, wherein an interior channel extends between the distal and proximal ends; an inserter shaft (FIG. 2) having a proximal and a distal end portion, the distal end portion capable of holding a closure mechanism for the spinal implant, wherein the shaft is sized to fit within the interior channel of the body; and a guide mechanism (pin, ref. #11 and corresponding channel, ref. #10) co-operable with the shaft and the body whereby the guide mechanism limits an independent movement of the shaft within the body, the guide mechanism including a channel and a pin adapted to fit within the channel, the channel

located on the body and extending parallel to a longitudinal axis of the body, the pin located on the shaft. The tool comprises a substantially cylindrical outer sleeve (ref. #6) disposed about the distal end portion of the body and movable between a first position and a second position in which the outer sleeve inhibits separation of the branches. (claim 11). A portion of the channel branches off at an angle and reverses direction (see ref. #27) (claim 15). A point where the channel branches off corresponds to the point where the spinal rod is fully seated in the implant (claim 16). The angle is approximately 90 degrees (claim 17). The pin and channel prevent the shaft from being removed from the body [in the distal direction] (claim 18). The independent movement limited is a rotational orientation of the inserter shaft with respect to the body (claim 19). The independent movement limited is an axial translation of the inserter shaft with respect to the body (claim 20).

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison et al. (U.S. Patent 5,910,141).

Morrison et al. disclose a tool comprising a body (ref. #14, 18) having a proximal end portion and a distal end portion, said distal end including a first and second flexible branch (ref. #36/38) for gripping a spinal implant; an inserter shaft (FIG. 11b, ref. #88 and ref. #39) slidably received within said body, said inserter shaft having a distal end (ref. #88) adapted to hold a closure mechanism for said implant; a threaded collar (ref. #16), adapted to couple said body and said inserter shaft, wherein said inserter shaft forces a spinal rod into the rod-receiving portion of said implant, and a substantially cylindrical outer sleeve (ref. #12) rotatably and slidably mounted onto said distal end of

said body, said outer sleeve movable between a first and second position, said body including a pin (ref. #24) projecting from said body and said outer sleeve has a channel for receiving said pin. The body further comprises external threads (ref. #28) to engage with the threaded collar.

***Allowable Subject Matter***

Claims 7 and 9 are allowed.

***Response to Arguments***

Applicant's arguments filed 09/07/2007 have been fully considered but they are not persuasive.

Applicant argues that the device of Becker fails to disclose a substantially cylindrical outer sleeve disposed about the distal end portion of the body and movable between a first position and a second position in which the outer sleeve inhibits separation of the branches. The examiner respectfully disagrees. Ref. #6 is being considered the cylindrical outer sleeve. Ref. #6 is a cylindrical component that is disposed about, *i.e.* in the area or vicinity (see [www.onelook.com](http://www.onelook.com) for definition of "about"), the distal end portion of the body. Furthermore, ref. #6 is movable between a first position and a second position (functional language) and inhibits at least some separation of the branches. With regards to the functional statements in the claims, *e.g.* movable between a first position and a second position, they do not impose any structural limitations on the claims distinguishable over Becker, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA

1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant also argues that the device of Morrison does not disclose a substantially cylindrical outer sleeve. Rather, Applicant states that ref. #12 is a lever arm that cannot be considered substantially cylindrical. The examiner respectfully disagrees. Ref. #12 conforms to the cylindrical body ref. #14 and forms a partial sleeve, thus, it can be considered "substantially cylindrical outer sleeve."

It is further noted that it has been held that the term "substantially" is a broad term. *In re Nehrenberg*, 280 F 2d 161, 126 USPQ 383 (CCPA 1960).

The rejections are deemed proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER